

REMARKS

This responds to the Office Action mailed on December 12, 2005, and the references cited therewith.

Claims 1-40 are now pending in this application.

§102 Rejection of the Claims

Claims 1-7 and 25-30 were rejected under 35 U.S.C. § 102(b) for anticipation by Yahoo! ("Yahoo Launches Three New European Auction Services; Yahoo! Italy, Yahoo! Spain and Yahoo! Sweden Unveil New Local Auctions"; hereinafter Yahoo).

Applicants respectfully submit that claims 1-7 and 25-30 should not be rejected under 35 U.S.C. § 102(b) for the reason that Yahoo does not disclose each and every limitation of the claim 1 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1 includes the following limitations:

determining a site that a user accesses....

retrieving a category list available for the site...and

communicating the category list to the user....

the category list is a region-specific category list.

The Office Action, in rejecting claim 1, does not identify any specific text from Yahoo with regard to the above limitations; however, the following may be relevant:

Sellers can conveniently market items in the local currency to regional buyers or to a global audience from any Internet-connected computer. From across the world, buyers can access items available in multiple languages and regions around the globe.

Yahoo, page 1, first paragraph.

The above quote from Yahoo describes seller marketing items and buyers accessing items. Sellers may market items to regional buyers or to a global audience. Buyers may access items in multiple languages and regions.

Claim 1 requires retrieving a region-specific category list that may be available for a site that a user accesses and communicating the region-specific category list to the user. In one embodiment, merely for example, a network-based commerce facility may retrieve and communicate an Australian category list to a user that accesses the network-based commerce facility from an Australian site.

In contrast, the above quote from Yahoo does not describe retrieving a region-specific category list that may be available for a site that a user accesses and communicating the region-specific category list to the user; rather, the above quote from Yahoo describes sellers that may market items and buyers that may access items. Indeed the above quote from Yahoo does not describe category lists, much less region-specific category lists, or the retrieving or communicating of such lists.

Responding to the above argument the Office Action states:

“A user that selects a region-specific site and receives by the system the region-specific site web page demonstrates the system determined the site the user entered. The user having entered the region-specific site receives local content.”

Office Action, Page 2, “Pertaining to Rejection under 35 USC 102...”

With all due respect the above response does not address the previously mentioned limitations of claim 1. Specifically, the above response states, “[t]he user having entered the region-specific site receives local content.” Clearly “local content” is not the same as a region-specific category list, as required by claim 1. Yahoo therefore cannot be said to anticipate the above quoted limitation because Yahoo describes sellers that may market items and buyers that may access items and claim 1 requires retrieving a region-specific category list available for a site that a user accesses and communicating the region-specific category list to the user.

Independent claim 25 includes a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim. Accordingly, Applicants request that the above remarks also be considered when examining independent claim 25 for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 2-6 and 26-30 under 35 U.S.C. § 102(b) is also addressed by the above remarks.

The Office Action stated that claim 7 was rejected under 35 U.S.C. § 102(b) (Paragraph 3). However, Applicants assume the Office Action did not intended to reject claim 7 under 35 U.S.C. § 102(b) because a reason for rejection was not provided and further because the Office Action rejected claim 7 under 35 U.S.C. §103(a) (Paragraph 4). Applicants have responded below to the rejection of claim 7 under 35 U.S.C. §103(a).

§103 Rejection of the Claims

Claims 7-12, 18-24 and 31-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yahoo! in view of M2P ("HP completes online strategy with launch of e-commerce site"; hereinafter M2P).

Applicants respectfully submit that claims 7-12, 18-24 and 31-36 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 7 includes the following limitations:

displaying a listing currency in conjunction with a native currency to the user.

The Office Action highlights the following disclosure in M2P:

HP also announced the HP Commerce Center which enables customers to select and buy HP products in local currency and in Euros from a list of five local resellers.

The above quote from M2P describes a Commerce Center. The Commerce center enables customers to select and buy HP products in local currency. Further, the Commerce center enables customers to select and buy HP products in Euros.

Claim 7 requires displaying a listing currency in conjunction with a native currency to a user. In contrast M2P does not describe a listing currency in conjunction with a native currency to a user; rather, MP2 describes customers that select and buy HP products in a local currency of the customer and in Euros. M2P therefore cannot be said to teach or suggest the above quoted limitation of claim 7 because M2P describes MP2 describes customers that select and buy HP products in a local currency and in Euros and claim 7 requires displaying a listing currency in conjunction with a native currency to a user.

The above remarks are also applicable to a consideration the independent claims 18 and 31. Accordingly, Applicants request that the above remarks be considered when examining these other independent claims for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 8-12, 19-24, and 32-36 under 35 U.S.C. § 103(a) is also addressed by the above remarks.

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yahoo! in view of M2P, as applied to claim 7, and in view of Pollick, SOLD! On eBay As Antique and Collectible Dealers See Their Sales Increase Through Online Auctions Such as eBay, More of Them are Deciding.....Afraid Of'; hereinafter Pollick). Claim 13 depends from independent claim 7. As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claim 13 under 35 U.S.C. § 103(a) is also addressed by the above remarks.

In summary, Yahoo in combination with M2P and in combination with Pollick does not teach or suggest each and every limitation as required to support rejections of the independent claims 7, 18, and 31 of the present application under 35 U.S.C. § 103.

Claims 14-17 and 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wells Fargo ("Mitsubishi Venture, Wells Fargo Partner to Offer Multi-Currency E-Commerce Storefront"; hereinafter Wells Fargo) in view of M2P.

Applicants respectfully submit that claims 14-17 and 37-40 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Claim 14 includes the following limitations:

displaying the listing currency in conjunction with the native currency to a use

The Office Action highlights the following disclosure in M2P:

HP also announced the HP Commerce Center which enables customers to select and buy HP products in local currency and in Euros from a list of five local resellers.

Independent claims 14 and 37 include the same discussed limitation of independent claim 7. Accordingly Applicants request that the above remarks also be considered when examining these other independent claims for allow ability.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 15-17 and 38-40 under 35 U.S.C. § 103(a) is also addressed by the above remarks.

In summary, Wells Fargo in combination with M2P does not teach or suggest each and every limitation of the claims 14 and 37 as required to support rejections of the independent claims 14 and 37 of the present application under 35 U.S.C. § 103.

Documents Cited but Not Relied upon for this Office Action Documents Cited but Not Relied upon for this Office Action Documents Cited but Not Relied upon for this Office Action

Applicants need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action since these references are not made part of the rejections in this Office Action. Applicants are expressly not admitting to this assertion and reserve the right to address the assertion should it form part of future rejections.



RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/905,525

Filing Date: July 13, 2001

Title: METHOD AND SYSTEM FOR LISTING GOODS GLOBALLY AND REGIONALLY, AND CUSTOMIZED LISTING ACCORDING TO CURRENCY OR SHIPPING AREA

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Dkt: 2043.130US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date 4/12/2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 12 day of April, 2006.

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